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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/799,542	03/11/2004	Carol B. Jessup	END920030113US1	7836
30400 7590 01/22/2009 HESLIN ROTHENBERG FARLEY & MESITI P.C. 5 COLUMBIA CIRCLE ALBANY, NY 12203			EXAMINER PATs, JUSTIN	
			ART UNIT 3623	PAPER NUMBER
			MAIL DATE 01/22/2009	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/799,542	<b>Applicant(s)</b> JESSUP ET AL.	
	<b>Examiner</b> JUSTIN M. PATS	<b>Art Unit</b> 3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 16 December 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-3,5,6,8-10,12,13,15-17 and 20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,5,6,8-10,12,13,15-17 and 20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

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**DETAILED ACTION**

***Notice to Applicant***

1. The following is a Final office action. In response to Examiner's communication of 9/18/08, Applicant, on 12/16/08, amended claims 1, 8, and 15, and cancelled claims 4, 7, 11, 14, 18, and 19. Claims 1-3, 5-6, 8-10, 12-13, 15-17, and 20 are pending in this application and have been rejected below.

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1–3, 5–6, 8–10, 12–13, 15–17, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Whitacre et al., U.S. Pat. Pub. No. 2004/0138944 [hereinafter Whitacre], also evidenced by Whitacre et al., Provisional Application, 7/22/02, pg. 1–76 [hereinafter Provisional] in view of Miller, U.S. Pat. Pub. No. 2002/0165752.

4. As per claim 1, Whitacre teaches a method of assessing an effort comprising: identifying multiple possible root causes of trouble for an effort (Whitacre, ¶ 0086); identifying multiple questions sets for the multiple possible root causes of trouble, each question set being directed to diagnosing a respective root cause of trouble of the multiple possible root causes of trouble (Whitacre, ¶ 0087–88; Provisional, pg. 64–74, especially pg. 66–68, Root Cause Analysis Chart, which lays out a plurality of question sets for different potential root causes for diagnostic purposes—for example, the question set on pg. 67, **1) Has a team member received feedback that indicated the performance is less than satisfactory?**, and **2) Will the team member be surprised that his/her performance is less than satisfactory?** are directed to diagnosing **Whether or not the team member knows that the performance is less than satisfactory**, which is one of the multiple possible root causes of the problem because if someone does not

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know there is a problem, they will be inclined to alter or change their ways in order to fix the problem. Further demonstrating this teaching of Whitacre is the question set on pg. 67, **1) Does the Team Member lack the authority, time or tools?, 2) Are there conflicting demands on the Team Member's time?, and 3) Are there outdated or unruly restrictive policies in place?**), which is directed to diagnosing **Whether there are obstacles beyond the Team Member's control**, which is one of the multiple possible root causes of the problem because if there is an obstacle that is out of one's control, they will likely be unable to remedy that situation) and identifying specific project role(s) to provide responses to questions of the question set (Provisional, pg. 67–68, identifying **team members'** actions and circumstances dictating the question sets, associate responses, and corrective action); evaluating answers to the question sets and provide guidance based on the scored questions regarding existence of one or more root causes of trouble for the effort from the identified multiple possible root causes of trouble (Whitacre, ¶ 0086, “The following is a list of tools that can help determine the root cause: Brainstorming, Cause and effect analysis (fishbone diagram), Histogram, Graphs, Pareto diagrams, and Checklists.).

Whitacre does not explicitly teach wherein the project or effort is one of product development, or where the tools are computer-implemented. Regarding the type of project being one of product development, this constitutes nonfunctional descriptive material and should not be given patentable weight. The type of a particular project, without positive functional recitation as to its distinctive use, amounts to mere labeling of data and does not functionally alter the method of assessing a project. See MPEP 2106.01 [R-5]. Nonfunctional descriptive material cannot lend patentability to an invention that would otherwise have been anticipated by the prior

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art. When descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability (*see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994)). Thus, this further purported limitations of claim 1 fails to further limit the invention as claimed.

Regarding computer-implementation, Whitacre teaches this functionality, especially as applied in its computer-implemented employee scorecard and dashboard tools (Whitacre, Figs. 1, 3–4, and 14; ¶ 0030, discussing the reporting tool functionality). Applying the known technique of computer implementation to a known device, the root-cause tools, ready for improvement, would have been obvious to one having ordinary skill in the art at the time of the invention to achieve a predictable result and result in an improved system that produces results more expediently with less effort and thus saves the user significant time and resources. Moreover, merely providing an automatic means, namely a computer and its standard components, operating a computer program embodied on a computer readable medium, to replace a manual activity which accomplishes the same result is not sufficient to distinguish over the prior art. *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958).

Whitacre teaches an automated scoring mechanism that generates a scorecard that scores and employee based on their performance (*see e.g.*, Whitacre, Fig. 8, showing Employee A's performance results in the form of scores in categories such as effectiveness and attendance; Fig. 3, Employee Scorecard) but does not explicitly apply it to the root-cause analysis tool in the manner claimed by Applicant. Miller, in the analogous art of employer-based testing, teaches scored questions produced by an automated scoring mechanism, the automated scoring

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mechanism automatically counting the number of responses in required fields of a question set of the multiple question sets and scoring the question set against a total number of required fields in the question set to produce an automatic indication of the strength of responses for the question set (Miller, ¶ 0247).

It would have been obvious to one of ordinary skill in the art to modify Whitacre to include the teaching of Miller because the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Finally, Whitacre in view of Miller does not explicitly teach the strength of responses indication being an automatic indication of the strength of analysis of the respective root cause of trouble. However, Miller documents and analyzes responses to all questions in all categories. As such, it is readily capable of monitoring quantities and qualities of answers to questions as well as questions that have not been answered upon submission of a test. Test results with a relatively small number of questions/responses indicate a relative lack of strength of analysis versus test results with a large number of questions/responses. Furthermore, Official Notice is taken that the greater the number of pertinent questions answered, the stronger the result set.

It would have been obvious to one of ordinary skill in the art to modify Whitacre to include the teaching of Miller and/or Official Notice because the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

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5. As per claim 2, Whitacre teaches evaluating project management processes employed for the effort by comparison thereof to identified, standard project management processes (Whitacre, ¶ 0088, “c) Does the Team Member know that the performance is less than satisfactory (e.g., feedback given to team member, team member aware of unsatisfactory performance)? If yes, consider the basis for how you know the team member is aware that his performance is less than satisfactory. Else, provide appropriate feedback to the team member. (d) Does the Team Member know what is supposed to be done and when (i.e., objectives and standards been defined and mutually agreed upon and clearly stated)? If yes, how do you know the Team Member knows what is suppose to be done and when? Else, set clear goals, objectives and standards with the Team Member to clarify expectations.”), and wherein the tool provides guidance regarding effectiveness of implementation of the project management processes employed for the effort (*id.*; *see also* Whitacre, ¶ 0086). As per product development and computer-implementation, see the rejection of claim 1.



6. As per claim 3, Whitacre teaches evaluating project management work product of the effort and inputting work product assessment to the tool as further evidence of the existence of the one or more root causes of trouble for the product development effort or the effectiveness of implementation of the project management processes employed for the effort Whitacre, (¶ 0088, “a) Is there a performance gap (i.e., basis, difference from target)? If so, what is the performance gap? Else, no further analysis required.”). As per product development and computer-implementation, see the rejection of claim 1.

7. As per claim 5, identifying in the tool the specific project personnel roles to answer questions of the multiple question sets (Whitacre, “¶ 0086, “(a) Enlist individuals to help in the root cause analysis. Include individuals that are directly affected by the outcome of the actions to be taken (e.g., Subject Matter Expert, another Team Leader/or an Operations manager”; Whitacre, ¶ 0088, discussing questions given by team leader or other interested individual regarding team members performance and project circumstance). Whitacre does not explicitly teach wherein the question sets also reside in the computer-implemented tool. However, storing project performance management data in a computer implemented tool was old and well known in the art as evidenced at least by Whitacre (Whitacre, ¶ 0030, Fig. 1, ref. 12, Consolidated-Reporting Database).

Because each individual element and its function are shown in the prior art, albeit in different references or embodiments, the difference between the claimed subject matter and the prior art rests not on any individual element or function but in the very combination itself—that

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is in the substitution of question sets for the reporting data of Whitacre. Thus, the simple substitution of one known element for another producing a predictable result renders the claim obvious.

8. As per claim 6, Whitacre does not explicitly teach wherein the product development effort comprises one of a software development project or a hardware development project. Regarding the type of project, this constitutes nonfunctional descriptive material and should not be given patentable weight. The type of a particular project, without positive functional recitation as to its distinctive use, amounts to mere labeling of data and does not functionally alter the method of assessing a project. See MPEP 2106.01 [R-5]. Nonfunctional descriptive material cannot lend patentability to an invention that would otherwise have been anticipated by the prior art. When descriptive material is not functionally related to the substrate, the descriptive material will not distinguish the invention from the prior art in terms of patentability (*see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994)). Thus, this further purported limitations of claim 6 fails to further limit the invention as claimed.

9. Claims 8–10, 12–13, and 15–17, and 20 recite limitations that stand rejected via the art citations and rationale applied to claims 1–3, 5–6, 1–3, and 6, respectively, as discussed above.

***Response to Arguments***

10. Applicant's arguments filed 12/16/08 have been fully considered but they are not persuasive.

11. Applicant asserts that Examiner's rejection fails because a root cause analysis concerning a product development project is patentably distinct from a root cause analysis that manages an individual's employee performance. Applicant's Remarks, 12/16/08, pg. 8. Furthermore, Applicant points to the fact that the potential root causes are different, and that Whitacre's root cause analysis tool would not scale to one in the product development process. *Id.* In response, Examiner respectfully disagrees. First, it is noted that the features upon which applicant relies (i.e., possible root causes specific to the product development process, as well as the creation of a tangible product based on the root cause analysis) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Furthermore, as currently claimed, Whitacre in view of Miller teaches all the requisite functionality for a root cause analysis directed toward the product development process, regardless of whether the questions it uses are the same as those contemplated by the Applicant because the answers to those questions and the subsequent analysis are not being used in a functionally different manner than in Whitacre. Monitoring and evaluating employee performance can have a significant impact of the product development process because efficient employees make better products and more of them. Therefore, Applicant's argument is unavailing.

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12. Applicant argues that Whitacre does not teach multiple question sets. Applicant's Remarks, 12/16/08, pg. 9. Examiner respectfully disagrees. Whitacre indeed teaches this limitation as discussed above in the rejection of claim 1.

13. Applicant argues that Whitacre does not teach identifying specific project role(s) who are to provide responses to the questions in that question set. Applicant's Remarks, 12/16/08, pg. 9. Examiner respectfully disagrees. Whitacre indeed teaches this limitation, as currently claimed, as discussed above in the rejection of claim 1.

14. Applicant argues that Whitacre fails to teach or suggest evaluating the strength of analysis of a respective root cause of trouble. Applicant's Remarks, 12/16/08, pg. 10. This limitation is considered obvious given the cited art and rationale provided above in the rejection of claim 1.

***Conclusion***

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JUSTIN M. PATS whose telephone number is (571)270-1363. The examiner can normally be reached on Monday through Friday, 8:00am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beth Boswell can be reached on 571-272-6737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Justin M Pats/  
Examiner, Art Unit 3623

/Andre Boyce/  
Primary Examiner, Art Unit 3623